



Docket No.: 052-037

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[GROUP 320]

#6 Reg Delors

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

85
8/18/89

Applicant: Lemelson

) Examiner: Bilinsky

Serial No.: 049,381

) Art Unit: 322

Filed: May 13, 1987

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Neil F. Markva

The Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Name of applicant, assignee or
registered representative

Signature
August 9, 1989

Date of Signature

RESPONSE

Sir:

This is in response to the outstanding office action dated July 17, 1989.

The specification has been objected to under 35 USC 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as now claimed. The examiner's only objection is that "the specification and the drawings fail to disclose the 'storage means' as presently claimed."

In the preliminary amendment filed with the Patent and Trademark Office beginning at Pages 44 thru 77 therein, support for each claim limitation in the claims copied from the Williamson Patent '563 has been shown with particularity. The limitation of "storing" each workpiece holder so that each workpiece is accessible, is found to exist as specifically referred to as "(JHL-B, JHL-C, necessary work-in-progress step with respect to

conveyor 75 which acts as storage means when workpiece not being worked on by a machine tool; branch conveyors, Page 42, lines 24-28)"

The examiner has simply ignored this particular showing throughout these claims for this particular limitation. Not only is there support in the specific language of this written description as noted but also in the drawings as specifically filed. See in particular Figures 6 and 7 which show conveyor 75. The use of branch conveyors is disclosed in the written description at Page 42. See also the designations JHL-B and JHL-C as explained at Page 2 of the declaration of Neil F. Markva filed with the continuation application. See also the same explanation at Page 2 of the declaration of Jerome H. Lemelson filed with the continuation application. The examiner has chosen to ignore this specific disclosure of the "storage means" as claimed in the present case.

Furthermore, the examiner has failed to cite any evidence to controvert Applicant's position. To simply state that the specification and drawings "fail to disclose the 'storage means' as presently claimed," without supporting his own position is inappropriate under the law because it is nothing more than conjecture.

It is well settled patent law that Applicant's invention is limited only to that on which his claims read. It follows that it is not necessary to describe in any written description and drawings all forms of the invention that may be embraced by the claims. That is, the claims necessarily embrace any form of Applicant's invention on which his claims read.

Applicant has very clearly specified in his originally filed written description, the portion of the specification on which his claims particularly read. The examiner clearly agrees with the Applicant inasmuch he rejects the claimed subject matter as reading on the Williamson '563. We fully agree with that. In fact, Applicant so fully agrees with the examiner's position that he has copied the claims two years ago and the Patent Office is just coming around to respond to that preliminary amendment which was filed having a priority date of 1954. Furthermore, Applicant's showing that his invention made at the time of filing the above application in November, 1987 has been ignored.

The examiner cannot have it both ways, Applicant either shows the storage means or it cannot be rejected over 35 USC 102. He admits that novelty does not exist. On the other hand, he says there is no support for the claim limitations. The claims themselves constitute part of the specification; the specification clearly shows conveyor 75; and discusses one or more branch conveyors for "temporarily holding work in process until a machine tool or tools are available to perform preprogrammed operations thereon." "Holding work" is a storing function. Applicant's claims read on this structure and precise function.

The examiner ignores that particular language in the specification which clearly supports the claim language and submits no evidence to support his position that Applicant does not disclose a "storage means." To take this position two full years after the filing of the application in which these claims are copied is untenable and reprehensible. This is particularly true in view of what is happening in the industry where the

Williamson assignees are licensing the entire machine tool industry on the very subject matter covered by Applicant's claims.

Based on the examiner's own rejection over 35 USC 102, it is respectfully submitted that Applicant's claims copied from Williamson '563 necessarily should place this case in interference with Williamson '563.

Where the scope of the subject matter is clear, and because Applicant has not otherwise indicated any intention for the claims to be of a different scope than as presented as originally filed, then the claims do particularly point out and claim the invention pursuant the first sentence of the second paragraph of the 35 USC 112. Furthermore, Applicant has produced uncontroverted support for the limitation "storage means" in the originally filed claims thereby establishing that the present application fulfills the "enabling" requirement of the first paragraph of 35 USC 112.

Thus, the scope of the claimed subject matter is governed not by the examiner's conception of the "invention" but by what Applicant regards his invention as set forth by the boundaries of the claim language employed. In re Borkowski, 164 USPQ 642 (CCPA 1970); In re Wakefield, 164 USPQ 636 (CCPA 1970).

In view of the foregoing, favorable reconsideration and early action on this application is respectfully requested. It is respectfully requested in accordance with the request made in the preliminary Amendment that an interference declared with the Williamson Patent '563. It is respectfully submitted that the effective filing date of the present claims is traceable all the way back to 1954 as presented in the evidence on the record and ignored by the examiner. Furthermore, even if there is any

unbroken chain, Williamson '563 can be overcome pursuant 37 CFR 1.131 based upon the disclosure of Applicant's earlier filed applications including Serial No. 449,874 filed July 28, 1954; Serial No. 557,415 filed April 10, 1956; and application Serial No. 152,707 filed October 17, 1961. Each of these specifications have been shown to support Applicant's present claims.

In view of the foregoing, favorable reconsideration of the objections is respectfully requested. Early allowance of the claims is earnestly solicited.

Respectfully submitted,

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